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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/506,432	02/17/2000	John R. Stevens	032795-001	6452

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EXAMINER

FRENEL, VANEL

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 02/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/506,432

Applicant(s)

STEVENS ET AL.

Examiner

Vanel Frenel

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 55-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 55-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the Amendment filed on 10/30/03. Claims 1-15 and 55-69 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-15 and 55-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leatherman (5,544,044) in view of Johnson et al (4,987,538).
(A) As per claim 1, Leatherman discloses a system comprising: software accessed at a provider computer (Col.3, lines 32-67 to Col.4, line 67).

Leatherman does not explicitly disclose that the software adapted to prompt the provider to input data concerning a workers' compensation claim, the software adapted to send an electronic claim number request containing at least some of the data across the Internet to a workers' compensation claim verification system; and a workers' compensation claims verification system adapted to receive the at least some of the data and to determine therefrom any matching workers' compensation claim number, if there is a matching workers' compensation claim number, the workers' compensation claims verification system is adapted to electronically supply the matching workers'

Art Unit: 3626

compensation claim number to the provider computer, if there is no matching workers' compensation claim number, the workers' compensation claims verification system is adapted to produce an indication of the lack of the workers' compensation claim number.

However, these features are known in the art, as evidenced by Johnson. In particular, Johnson suggests the software adapted to prompt the provider to input data concerning a workers' compensation claim, the software adapted to send an electronic claim number request containing at least some of the data across the Internet to a workers' compensation claim verification system (See Johnson, Col.2, lines 1-67 to Col.3, line 49); and a workers' compensation claims verification system adapted to receive the at least some of the data and to determine therefrom any matching workers' compensation claim number, if there is a matching workers' compensation claim number, the workers' compensation claims verification system is adapted to electronically supply the matching workers' compensation claim number to the provider computer, if there is no matching workers' compensation claim number, the workers' compensation claims verification system is adapted to produce an indication of the lack of the workers' compensation claim number (See Johnson, Col.2, lines 1-67 to Col.3, line 49).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Johnson within the system of Leatherman for providing a method for processing provider billings under insurance claims where

Art Unit: 3626

determination of maximum allowable pay out for a provider billing is controlled by a detailed and complex array of administrative rules (See Johnson, Col.1, line 6-10).

(B) As per claim 2, Johnson discloses the system wherein the indication is an electronic signal from the Workers' Compensation claims verification system to a payer computer (Col.3, lines 14-25).

(C) As per claim 3, Johnson discloses the system wherein the indication is a signal to other software systems co-located with the workers' compensation claims verification system (Col.5, lines34-67 to Col.6, line 67).

(D) As per claim 4, Johnson discloses the system wherein the workers' compensation claims verification system electronically requests a workers' compensation claim number from a payer computer (Col.2, lines 1-67 to Col.3, line 49).

(E) As per claim 5, Johnson discloses the system wherein the software accessed at the provider computer is part of a workers' compensation medical treatment reporting system (Col. Col.2, lines 1-67 to Col.3, line 49).

(F) As per claim 6, Johnson discloses the system wherein the software accessed at the provider computer is adapted to use the workers' compensation claim number obtained from the Workers' Compensation claim verification system to produce medical

Art Unit: 3626

treatment reports including the Workers' Compensation claim number (Col. Col.2, lines 1-67 to Col.3, line 49).

(G) As per claim 7, Johnson discloses the system further comprising multiple providers, each having a provider computer containing Workers' Compensation software, each of the provider computers being operably connected to the Workers' Compensation claim verification system across the Internet (Col.2, lines 1-67 to Col.3, line 49).

(H) As per claim 8, Johnson discloses the system wherein the Workers' Compensation claim verification system contains claim data for a number of payers (Col.2, lines 1-67 to Col.3, line 49).

(I) As per claim 9, Johnson discloses the system wherein the Workers' Compensation claim verification system is updated with data obtained from payer computers (Col.2, lines 40-67 to Col.3, line 25).

(J) As per claim 10, Leatherman discloses the system wherein at least some of the data sent across the Internet includes name data, social security data, and injury date data (Col.8, lines 18-50).

Art Unit: 3626

(K) As per claim 11, Johnson discloses the system wherein the Workers' Compensation claim verification system is adapted to interface with a payer computer to request a Workers' Compensation claim number using a database at a server, and in response to a claim verification request from a provider computer received at the server database, retrieve a claim number from the database and provide the claim number to the provider computer (Col.2, lines 1-68 to Col.3, line 49).

(L) As per claim 12, Johnson discloses the system wherein the Workers' Compensation claim verification system is adapted to receive claim numbers from any number of payer computers and match the payer claim numbers with claim verification requests received by the database from any number of provider computers (Col.2, lines 1-68 to Col.3, line 49).

(M) As per claim 13, Johnson discloses the system wherein the Workers' Compensation claim verification system received blocks of unassigned claim numbers from payer computers and the Workers' Compensation claim verification system, and assigns claim numbers to injuries from the blocks of unassigned claim numbers in response to claim verification requests received by the Workers' Compensation claim verification system from provider computers (Col.2, lines 1-67 to Col.3, line 49).

(N) As per claim 14, Johnson discloses the system wherein the Workers' Compensation claim verification system includes software that is adapted to allow a

Art Unit: 3626

provider computer to access a payer computer, and payer computer to access the provider computer, for the purpose of requesting and supplying claim numbers (Col.2, lines 1-67 to Col.3, line 49).

(O) As per claim 15, Johnson discloses the system wherein the Workers' Compensation claim verification system is maintained at a payer computer (Col.2, lines 1-67 to Col.3, line 49).

(P) Claim 55 differs from claim 1 by reciting a system for processing workers compensation claim information comprising:

As per this limitation, it is noted that Leatherman discloses a computer programmed to accept information, which information may include a corresponding claim number, from a provider of medical services (Col.3, lines 32-67 to Col.4, line 67); said computer operative to transmit a subset of the information, including the corresponding claim number if the claim number is present in the information, to a verification means comprising: a database of rules to reconcile billing data required by a recipient of the subset of information (Col.7, lines 49-67 to Col.8, line 67); and Johnson discloses an associated database, and an indicator, wherein said databases are utilized to determine if the subset of the information includes a valid claim number, and if the subset of information does not include a valid claim number the indicator produces an electronic signal (See Johnson, Col.5, lines 34-68 to Col.6, line 68).

Art Unit: 3626

Thus, it is readily apparent that these prior art systems utilize a system for processing workers compensation claim information to perform their specific function.

The remainder of claim 55 is rejected for the same reason given above for claim 1, and incorporated herein.

(Q) Claim 56 differs from claims 1 and 55 by reciting a method for processing workers compensation claim information comprising the steps of:

As per this limitation, it is noted that Leatherman discloses inputting information, which information may include a corresponding claim number, from a provider of medical services to a suitably programmed computer (Col.3, lines 31-67 to Col.4, line 67) and Johnson discloses transmitting a subset of the information, including the corresponding claim number if the claim number is present, to a verification means wherein the steps of verification include: accessing a database of rules to reconcile billing data required by a recipient of the subset of information and an associated database, and determining if the subset of the information includes a valid claim number (See Johnson, Col.5, lines 34-68 to Col.6, line 68).

Thus, it is readily apparent that these prior art systems utilize a method for processing workers compensation claim information to perform their specific function.

The remainder of claim 56 is rejected for the same reason given above for claims 1 and 55, and incorporated herein.

Art Unit: 3626

(R) As per claim 57, Johnson discloses the system wherein the electronic signal produced by the indicator is transmitted to a payer computer (Col.2, lines 1-67 to Col.3, line 49).

(S) As per claim 58, Johnson discloses the system wherein the electronic signal produced by the indicator is an electronic mail from the system for processing workers compensation claim information to a payer computer (Col.2, lines 1-68 to Col.3, line 49).

(T) As per claim 59, Johnson discloses the system wherein the electronic signal produced by the indicator includes a valid claim number (Col.3, lines 14-49).

(U) As per claim 60, Johnson discloses the system wherein the electronic signal produced by the indicator is transmitted from the system for processing workers compensation claim information to the provider of medical services submitting the information (Col.1, lines 13-57).

(V) As per claim 61, Johnson discloses the system wherein the database contains rules sufficient to reconcile billing data for one or more recipients (Col.1, lines 13-57; Col.5, lines 34-68 to Col.6, line 68).

(W) As per claim 62, Leatherman discloses the system wherein the database of rules for reconciling billing data required by a plurality of recipients, contains a subset of the

Art Unit: 3626

rules that are applicable to a corresponding recipient, and the verification means is configured to apply the subset of rules for reconciling billing data required by the corresponding recipient (Col.7, lines 49-67 to Col.8, line 67).

(X) As per claim 63, Johnson discloses the method wherein the indicator includes a valid claim number (Col.6, line 48-68).

(Y) As per claim 64, Johnson discloses the method wherein the indicator is transmitted to the recipient (Col.2, lines 1-68 to Col.3, line 49).

(Z) As per claim 65, Johnson discloses the method wherein the indicator is transmitted to the provider of medical services (Col.2, lines 1-67 to Col.3, line 49).

(AA) As per claim 66, Johnson discloses the method wherein the database contains rules sufficient to reconcile billing data for one or more recipients (Col.1, lines 13-57; Col.5, lines 34-68 to Col.6, line 68).

(BB) As per claim 67, Leatherman discloses the method wherein the database of rules contains a hierarchy of rules for reconciling billing data required by a plurality of recipients, a subset of which rules are applicable to a corresponding recipient, and the verification means is configured to apply the subset of rules for reconciling billing data required by the corresponding recipient (Col.7, lines 49-67 to Col.8, line 67).

Art Unit: 3626

(CC) As per claim 68, Leatherman discloses the method wherein if the subset of information does contain a valid claim number then indicating that the subset of information does contain a valid claim number (Col.4, lines 34-67 to Col.5, line 67; Col.6, lines 1-52).

(DD) As per claim 69, Leatherman discloses the method wherein if the subset of information does not include a valid claim number, then indicating that the subset of information does not contain a valid claim number (Col.4, lines 34-67 to Col.5, line 67; Col.6, lines 1-52).

Response to Arguments

4. Applicant's arguments filed 10/30/03 regarding claims 1-15 are considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 10/30/03.

(A) At pages 9-14 of the 10/30/03 response, Applicant's argues that the features in the 10/130/03 amendment are not taught by or suggested by the applied reference.

In response, all of the limitations which Applicant disputes as missing in the applied references, including the features newly added in the 10/30/03 amendment, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the collective teachings of Leatherman, and/or Johnson et al based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the

Art Unit: 3626

invention, as detailed in the remarks and explanations given in the preceding sections of the present Office Action and in the prior Office Action (paper number 12), and incorporated herein. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied art teaches method an article of manufacture fro providing a component based interface to handle tasks during claim processing (2003/0023473) and attachment integrated claims system and operating method therefor (6,343,310) and system for funding future workers compensation losses (5,613,072).

Art Unit: 3626

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 703-305-4952.

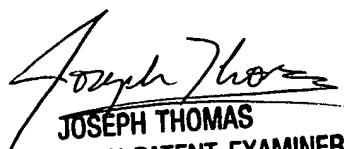
The examiner can normally be reached on 6:30am-5:00pm.

7. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

V.F
V.F

February 20, 2004


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600